



PATENT
REQUEST FOR RECONSIDERATION
AFTER FINAL REJECTION
EXPEDITED PROCEDURE EXAMINING GROUP 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/684,927

Confirmation No.: 2321

In re Application of:

Hideki USUKI et al.

Group Art Unit: 1775

Filed: October 10, 2000

Examiner: Ling X. Xu

For: PROTECTIVE LAYER TRANSFER SHEET

REQUEST FOR RECONSIDERATION

MAIL STOP AF

Commissioner for Patents

P. O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Applicants request reconsideration of the rejection in the Office Action mailed February 13, 2004 in view of the following remarks.

Claims 1 and 4 to 9 continue to stand rejected under 35 USC 103 as unpatentable over Oshima et al. '997 in view of Kanto et al. '112. The rejection was first made in an Office Action mailed February 15, 2002 and applicants and the Examiner have since that date presented differing views regarding whether the record in this

case supports patentability of the claims over the cited art. Applicants respectfully submit that the record supports patentability for the reasons presented to date and for the following reasons.

The range of fine particles to be added to a layer in the Kanto et al. '112 heat transfer sheet arrangement is disclosed as the range for particle addition to the dye layer. The patent at column 4, lines 9 to 29 clearly is discussing the dye layer. Although the patent later in column 4 discusses adding components (these components are "antistatics, antiblocking agents and slip agents"; see column 4, lines 31 and 32) to the adhesive layer, applicants say with respect that the person of ordinary skill in the art would not conclude (as the Examiner apparently has) that the range disclosed for fine particle addition to the dye layer in Kanto et al. '112 is also the range of additive content in the adhesive layer of that heat transfer sheet. As such, a basic premise of the combination rejection is undermined. The Examiner's interpretation of what Kanto et al. '112 is said to disclose has come about after reading applicants' claims and attempting to

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locate a showing of what is acknowledged to be missing from the primary reference.

The working and comparative examples in the application and in Mr. Hirota's 37 CFR 1.132 Declaration have established the advantages that are achieved by having microsilica present in an amount of 3 to 10 (not 0.3) % by weight in the adhesive layer. The Examiner is particularly directed to the arguments in the Request for Reconsideration filed March 24, 2003, the Further Arguments in Support of Patentability filed May 27, 2003, the Amendment Under 37 CFR 1.116 filed September 22, 2003, and the Argument in Support of Patentability filed December 11, 2003.

Applicants say with respect that the Examiner has misunderstood what Table 2 in Mr. Hirota's Declaration Under 37 CFR 1.132 shows. All values in parentheses in that table are values calculated representing the differences between the OD value at 0% and the OD values at 3%, 12%, and 20%, respectively. There is no two-membered grouping of 0% and 3% and a two-membered grouping of 12% and 20%. Four OD values are shown for each step and three differential values for each step are shown also. The larger quantities of microsilica (outside the claimed range) causes drops

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in OD at the higher steps; see steps 14 and 15, especially the latter. Those numbers and the numbers in the working and comparative examples establish patentability here.

A primary objective of the present invention is to provide a protective layer transfer sheet that does not present cockling problems when in a printer. The invention is a patentable improvement over the Oshima et al. '997 heat transfer cover films. Kanto et al. '112 has no discussion of overcoming problems of cockling by adding a designated quantity of microsilica (with a specified coefficient of static friction to coefficient of dynamic friction relationship) in an adhesive layer in a heat transfer sheet. The working and comparative examples show such advantages (see the discussion under "2. Evaluation of actual prints" on page 22 of the specification) and those examples as well as the examples in Mr. Hirota's declaration also show the optical density (print quality) advantages of the present invention; see, e.g., the paragraph bridging pages 23 and 24 of the specification and the declaration.

Applicants also submit with respect that the limitation in claim 1 regarding the ranges of coefficient of static friction and

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coefficient of dynamic friction and the ratio of those values is not an inherent property of the particles disclosed in Kanto et al. '112. The Examiner has relied on the discussion in applicants' specification on pages 4, 9, and 13 and the working example discussion on pages 21 and 24. Such reliance is improper. The secondary reference is silent about such relationships; they may not properly be made from whole cloth. The rejection should be withdrawn.

The Examiner is asked to contact the undersigned should any changes be required in the case prior to allowance.

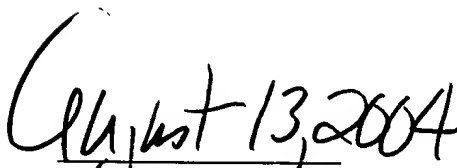
Respectfully submitted,

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